

Remarks/Arguments

Applicant thanks the Examiner for careful consideration of the application.

Please amend claims 1-7 and 9-12.

Please add new claims 13-15.

No claims have been allowed by the Examiner.

I. Brief history of case:

Applicant at this time is uncertain as to what claims are being prosecuted by Examiner. Originally claims 1-12 were pending in the application. In Applicant's response (dated September 17, 2002) to Examiner's 1st Office communication (dated May 22, 2002) Applicant amended claims 6, 11, and 12. Examiner then responded in a Final Office communication (December 12, 2002) allowing claims 1-5 and rejecting claims 6-12. Applicant responded (February 11, 2003) amending claims 6, 11, and 12, and adding new claim 13. Examiner in an Advisory Action (April 15, 2003) did not enter Applicant's proposed amendment. Applicant unintentionally abandoned application and petitioned to revive on July 2, 2003 which was subsequently granted September 9, 2003. Along with petition to revive Applicant submitted a response to Examiner's April 15, 2003 Advisory Action canceling claims 6-12 placing Applicant's application in condition for allowance.

Applicant believes the above history to be accurate, and therefore assumes Examiner's rejection of claims 1-13 based on the new cited prior art of Adoma DE 200 08 512 U1 places application in the same condition Application was in after Applicant's response (dated May 22, 2002) to Examiner's first Office communication. Therefore, Applicant assumes for purposes of this response that claims 1-12 are pending with claims 6, 11, and 12 having been once amended in Applicant's response

dated May 22, 2002. In addition, Applicant further assumes that there was no claim 13 pending at the time Examiner sent this Office communication.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Examiner has rejected claims 1-12, under 35 U.S.C. § 103(a) as being unpatentable over Adoma (DE 200 08 512 U1, "Adoma") in view of Wyatt (EP 0 429 195 A2, "Wyatt"). This rejection is respectfully traversed with regard to claims 1-12 since neither of the cited references, taken either individually, or in combination therewith, teach, suggest, or mention the claimed invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, i.e. the prior art must suggest the desirability of the claimed invention. There must be a reasonable expectation of success. Finally all claim limitations must be taught or suggested by the prior art. MPEP §2143. These requirements are not met here. In addition, to establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

In regards to amended independent claim 1, amended independent claim 1 discloses "a disk-shaped body having an essentially convex first surface and an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement," as it is disclosed, defined, and claimed, in amended independent claim 1 by Applicant in the instant specification. In contrast, Adoma teaches a "disk for throwing [that] is provided with a recessed part that is covered by a removable cover. The recessed part and the cover define a flat cavity, which can be used to mount and load therein a flat object, in particular a compact disk. Page 2, paragraph 3. In addition, Adoma discloses, "[t]he cover is preferably

held in place clamped so that on the edge region of the cover or of the recessed part is arranged a continuous or discontinuous reinforcement" Page 2, paragraph 4. Further, Adoma discloses, "the recessed part is preferably equipped with a centrally arranged clamping device, which is constructed in particular to achieve concentric, clamping mounting support for a compact disk." Page 2, paragraph 5. Thus, Adoma discloses a throwing disk having a recessed part, formed in the top or convex surface of the disk, that holds a compact disk and is covered with a removable cover. Adoma does not disclose, teach, or suggest a throwable implement having a plurality of flexible fingers disposed in a first circle on the second surface (i.e. essentially concave surface) and that protrude away from the second surface.

Further, Wyatt, does not disclose, teach, or suggest, "a disk-shaped body having an essentially convex first surface and an essentially concave second surface." In contrast, Wyatt teaches "[a]s illustrated in Figures 1 and 2, a compact disk storage case includes a tray 10 moulded from rigid plastics [sic] material." Col. 2, lines 36-38. In addition, Wyatt teaches "[a] central circular portion 15 of the base 14 of the recess 11 is raised relative to said base 14 . . . [where t]he central portion 15 defines a series of legs 20 arranged in angularly spaced relationship in a circle." Col. 2, lines 43-49. Further, Wyatt teaches "the legs 20 are on a diameter of a circular aperture 25 in the centre of disk 12 and are inclined slightly outwardly, so that . . . the legs 20 will engage and grip the sides of the aperture 25, to retain disk 12 in the recess 11." Col. 3, lines 2-8. Thus, Wyatt teaches a compact disk storage case including a tray having legs arranged in a circle that engage and grip the sides of a compact disk. Wyatt does not disclose, teach, or suggest "a disk-shaped body having an essentially convex first surface and an essentially concave second surface; and a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement." The combination of Adoma and Wyatt are silent on "a plurality of flexible fingers disposed in a first circle on said second surface and protruding for a predetermined distance away from said second surface, said first circle having a center essentially concentric with an axis of rotation of the implement." Thus, the Examiner's suggested combination of Adoma and Wyatt

does not teach the present invention as recited in amended independent claim 1, and thus, does not meet any of the three basic criteria that must be met to establish a prima facie case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of amended independent claim 1 based on Adoma in view of Wyatt under 35 U.S.C. § 103(a).

In regards to amended dependent claims 2-5, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP 2143.03. Amended dependent claims 2-5 are dependent upon amended independent claim 1, and are therefore believed to be allowable as dependent upon a believed allowable claim. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of amended dependent claims 2-5 under 35 U.S.C. § 103(a).

In regards to amended independent claim 6, amended independent claim 6 discloses "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation; a plurality of flexible fingers attached to said second surface, disposed in a first circle concentric with said axis of rotation, and protruding for a predetermined distance away from said second surface, whereby a recordable disk medium may be releasably coupled to said body," as it is disclosed, defined, and claimed, in amended independent claim 6 by Applicant in the instant specification. In contrast, as previously discussed above, Adoma teaches a throwing disk having a recessed part formed in the top or convex surface of the disk. Adoma does not disclose, teach, or suggest "a plurality of flexible fingers attached to said second surface, disposed in a first circle concentric with said axis of rotation, and protruding for a predetermined distance away from said second surface, whereby a recordable disk medium may be releasably coupled to said body."

Further, Wyatt, does not disclose, teach, or suggest, "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation." In contrast, as previously discussed above, Wyatt teaches a compact disk storage case including a tray having legs arranged in a circle that engage and grip the sides of a compact disk. Wyatt does not disclose, teach, or suggest "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation." The combination of Adoma and Wyatt are silent on "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation; a plurality of flexible fingers attached to said second surface, disposed in a first circle concentric with said axis of rotation, and protruding for a predetermined distance away from said second surface, whereby a recordable disk medium may be releasably coupled to said body." Thus, the Examiner's suggested combination of Adoma and Wyatt does not teach the present invention as recited in amended independent claim 6 and thus does not meet any of the three basic criteria that must be met to establish a prima facie case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of amended independent claim 6 based on Adoma in view of Wyatt under 35 U.S.C. § 103(a).

In regards to dependent claims 7-10, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP 2143.03. Dependent claims 7-10 are dependent upon amended independent claim 6, and are therefore believed to be allowable as dependent upon a believed allowable claim. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 7-10 under 35 U.S.C. § 103(a).

In regards to amended independent claim 11, amended independent claim 11 discloses,

"a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation, said disk-shaped body having an aperture extending through said disk-shaped body from said first surface to said second surface, said aperture having an areal shape congruent with and adapted to include a recordable medium, centered about said axis of rotation, and bounded along at least a portion of a periphery of said aperture by an indented lip pair having a spacing dimension between each lip of said lip pair equal to or less than the thickness dimension of said recordable medium, whereby said body removably encompasses said recordable medium,"

as it is disclosed, defined, and claimed, in amended independent claim 11 by Applicant in the instant specification. In contrast, as previously discussed above, Adoma teaches a throwing disk having a recessed part formed in the top or convex surface of the disk. Adoma does not disclose, teach, or suggest "disk-shaped body having an aperture extending through said disk-shaped body from said first surface to said second surface, said aperture having an areal shape congruent with and adapted to include a recordable medium, centered about said axis of rotation, and bounded along at least a portion of a periphery of said aperture by an indented lip pair having a spacing dimension between each lip of said lip pair equal to or less than the thickness dimension of said recordable medium, whereby said body removably encompasses said recordable medium."

Further, Wyatt, does not disclose, teach, or suggest, "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation, said disk-shaped body having an aperture extending through said disk-shaped body from said first surface to said second surface." In contrast, as previously discussed above, Wyatt teaches a compact disk storage case including a tray having legs arranged in a circle that engage and grip

the sides of a compact disk. Wyatt does not disclose, teach, or suggest "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation, said disk-shaped body having an aperture extending through said disk-shaped body from said first surface to said second surface." The combination of Adoma and Wyatt are silent on,

"a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation, said disk-shaped body having an aperture extending through said disk-shaped body from said first surface to said second surface, said aperture having an areal shape congruent with and adapted to include a recordable medium, centered about said axis of rotation, and bounded along at least a portion of a periphery of said aperture by an indented lip pair having a spacing dimension between each lip of said lip pair equal to or less than the thickness dimension of said recordable medium, whereby said body removably encompasses said recordable medium."

Thus, the Examiner's suggested combination of Adoma and Wyatt does not teach the present invention as recited in amended independent claim 11 and thus does not meet any of the three basic criteria that must be met to establish a prima facie case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of amended independent claim 11 based on Adoma in view of Wyatt under 35 U.S.C. § 103(a).

In regards to amended independent claim 12, amended independent claim 12 discloses "a recordable medium having a recordable medium mass; a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation; and means for removably attaching said recordable medium to said second surface of said disk-shaped body, essentially parallel to said second surface, and disposed with said recordable medium

mass essentially balanced about said axis of rotation,"as it is disclosed, defined, and claimed, in amended independent claim 12 by Applicant in the instant specification. In contrast, as previously discussed above, Adoma teaches a throwing disk having a recessed part formed in the top or convex surface of the disk. Adoma does not disclose, teach, or suggest "means for removably attaching said recordable medium to said second surface of said disk-shaped body, essentially parallel to said second surface, and disposed with said recordable medium mass essentially balanced about said axis of rotation."

Further, Wyatt, does not disclose, teach, or suggest, "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation." In contrast, as previously discussed above, Wyatt teaches a compact disk storage case including a tray having legs arranged in a circle that engage and grip the sides of a compact disk. Wyatt does not disclose, teach, or suggest "a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation." The combination of Adoma and Wyatt are silent on "a recordable medium having a recordable medium mass; a disk-shaped body having an axis of rotation, and having at least a first surface and an essentially concave second surface, causing aerodynamic lift when thrown and gyroscopic stability when freely rotating about said axis of rotation; and means for removably attaching said recordable medium to said second surface of said disk-shaped body, essentially parallel to said second surface, and disposed with said recordable medium mass essentially balanced about said axis of rotation." Thus, the Examiner's suggested combination of Adoma and Wyatt does not teach the present invention as recited in amended independent claim 12 and thus does not meet any of the three basic criteria that must be met to establish a prima facie case of obviousness under MPEP §2143. Accordingly, Applicant asserts that the rejection has been overcome. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of amended independent claim 12 based on Adoma in view of Wyatt under 35 U.S.C. § 103(a).

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PATENT APPLICATION

Attorney Docket No: 10014078-1

Therefore, in view of the foregoing Amendment and Remarks, Applicant believes the present application to be in a condition suitable for allowance. Examiner is respectfully urged to withdraw the rejections, reconsider the present Application in light of the foregoing Amendment, and pass the amended Application to allowance.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's representative at (541) 715-1694 to discuss the steps necessary for placing the application in condition for allowance.

Favorable action by the Examiner is solicited.

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